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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Russo & Hale LLP

Serial No. 76/100,804

Susan B. Horwitz of Russo & Hale for applicant.

Tarah K. Hardy Ludlow, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Russo & Hale LLP to register the designation COMPUTERLAW.COM for "legal services."¹ Applicant asserts that the mark it seeks to register is inherently distinctive but, in the alternative, claims, pursuant to Section 2(f) of the Trademark Act, that the designation COMPUTERLAW.COM has acquired

¹ Application Serial No. 76/100,804, filed July 21, 2000, asserting dates of first use anywhere and first use in commerce of November 15, 1995.

distinctiveness.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Act on the ground that the designation sought to be registered is generic and, thus, unregistrable.² In the event that the designation is found to be not generic but, rather, merely descriptive, the Examining Attorney also has refused registration on the Principal Register due to the insufficiency of the evidence supporting the claim of acquired distinctiveness.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that the designation COMPUTERLAW.COM, when used in connection with legal services, is generic because it comprises the generic term "computer law" and an entity designator which lacks trademark significance, namely, the generic top-level domain ("TLD") ".com." In support of the refusal, the Examining Attorney submitted excerpts from third-party Internet websites and excerpts from articles retrieved from

² The final refusal mistakenly cites to Section 23 of the Act. In her appeal brief, however, the Examining Attorney corrected this earlier misstatement.

the NEXIS database, all showing uses of the term "computer law" as a specific area of practice in the legal profession.

Applicant argues that its designation is inherently distinctive and is, at worst, just suggestive of "the way it offers its services as well as its connectivity and 'wired' relationship to emerging technologies, and as such the mark is suggestive of a certain genre of legal services." According to applicant, the designation COMPUTERLAW.COM is not the name of a type of legal services, but that the designation sends "a clear message to the public that Applicant's firm is connected to the Internet, that it offers services using modern communication methods, that the firm is accessible, and that it offers services that are technically advanced." Even in the event that the designation is found to be merely descriptive, applicant contends, it has acquired distinctiveness. Applicant asserts that the designation COMPUTERLAW.COM is a coined term, and that it was first used by applicant in 1995 before the "Internet boom." Prospective purchasers can access applicant's webpage at www.computerlaw.com to gain information about applicant's practice and legal news in the area of computer law. In support of its position, applicant introduced a copy of its

California state trademark registration for the designation sought to be registered herein and excerpts from its website on the Internet. With respect to acquired distinctiveness, applicant relies upon its use of COMPUTERLAW.COM since November 15, 1995 on its website and in all of its advertising and promotional materials. Applicant states that "[a]ll e-mail communications between applicant and existing clients and potential clients are conducted via [its] mark." Applicant also submitted copies of third-party registrations which show, according to applicant, inconsistent treatment by the Office regarding registrability of similar designations.³

Generic terms are common names that the relevant purchasing public understands primarily as describing the class of goods or services being sold. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). They are by definition

³ Certain registrations were made of record during the prosecution of the application. Other registrations were submitted for the first time with the brief (some were submitted in the form of certified copies of the registrations, and others are printouts from the TESS database), and applicant has requested that the Board take judicial notice of them. Third-party registrations are not proper subject matter for judicial notice. TBMP §712. Further, the submission is untimely. Trademark Rule 2.142(d). We note, however, that the Examining Attorney did not object to the untimely submission and, therefore, we have elected to consider the evidence in reaching our decision.

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incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001). The Office bears the burden of proving that a term is generic. In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1834 (Fed. Cir. 1999).

The determination of whether a term is generic involves a two-part inquiry: First, what is the category or class of the goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category of goods or services? H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

With respect to the first part of the genericness inquiry, the class or category of services at issue here is that of legal services, more specifically, legal services pertaining to the area of computer law. Applicant's specimen, a printout of its Internet webpage, shows that the law firm specializes in "computer software cases" and that the firm "has a networked office system, electronic mail facilities both internally and externally for clients,

as well as multiple networked IBM PC-based, NEXT, and Apple Macintosh-based computer systems."

We find that the record establishes that the term "computer law" is the name or type of a particular or specialized area of practice, and one in which applicant clearly is involved. In this connection, we note that applicant recognizes that "the legal industry uses the term 'computer law' to define a certain type of law." (brief, p. 5) The record is replete with generic uses of the term "computer law" as a name for a specialized area of the law, much in the same way that "administrative law" or "domestic relations law" is used. Examples of such uses in the NEXIS articles are as follows:

Computer law is going to be the big issue of the future...
(*The Florida Times-Union*, April 11, 2001)

One is Mark Grossman, an attorney with Becker & Poliakoff who specializes in technology and computer law in Miami.
(*The Record*, April 9, 2001)

Victoria M. Brown, an Englewood lawyer, will present a talk on "Computer Law: Legal Problems and Pitfalls of Having a Web Site Developed and Launched."
(*The New York Times*, March 11, 2001)

March 1-2, 2001. 21st Annual Institute on Computer Law
(*The National Law Journal*, February 26, 2001)

Mr. Hassett has over twelve years of experience in technology, licensing, computer law, trademark and commercial law.
(*The Metropolitan Corporate Counsel*, April 2001)

The Internet websites show similar uses. The front page of the New Jersey Law Network (www.njlawnet.com) lists several "Legal Topics" such as "Administrative Law," "Tax Law," "Intellectual Property," "Criminal Law," and "Computer Law." The website of www.law.freeadvice.com includes a topic titled "Computer Law."

The second step of the Ginn inquiry is whether the relevant public understands the term COMPUTERLAW.COM to refer to the category of legal services at issue. Here, we find that the term is so understood. As cited above, the evidence clearly establishes that the term "computer law" identifies a particular area of legal practice. This is exactly the area of the law in which applicant specializes. See: In re A La Vieille Russie Inc., 60 USPQ2d 1895 (TTAB 2001)[RUSSIANART generic for particular field or type of art and also for dealership services directed to that field]; In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999)[because LOG CABIN HOMES is generic for a particular type of building, it is also generic for architectural design services directed to that type of building, and for

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retail outlets featuring kits for construction of that type of building]; In re Web Communications, 49 USPQ2d 1478 (TTAB 1998)[because WEB COMMUNICATIONS is generic for publication and communication via the World Wide Web, it is also generic for consulting services directed to assisting customers in setting up their own Web sites for such publication and communication]; and In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984)[LAW & BUSINESS incapable of distinguishing applicant's services of arranging and conducting seminars in the field of business law].

In the present case, the recitation of services is broadly stated as "legal services," and the services clearly encompass such services in the area of computer law. And, if applicant's designation COMPUTERLAW.COM is generic as to part of the services applicant offers under its designation, the designation is unregistrable. In re Analog Devices Inc., 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd without pub. op.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); and In re Allen Electric and Equipment Co., 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972)[genericness is determined on the basis of the goods and/or services identified in the involved application].

In analyzing the issue, we have taken judicial notice of various dictionary definitions of ".com." See: *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)[dictionary definitions are proper subject matter for judicial notice]. The term ".com" is defined in the following ways: "a domain type used for Internet locations that are part of a business or commercial enterprise" CNET Glossary (1998); "abbreviation of commercial organization (in Internet addresses)" The American Heritage Dictionary of the English Language (4th ed. 2000); and "Internet abbreviation for company: used to show that an Internet address belongs to a company or business" Cambridge Dictionaries Online (2001).

The issue presently before us was addressed by the Board in two recent decisions. See: *In re CyberFinancial.Net, Inc.*, ___USPQ2d___ (TTAB August 28, 2002)(application Serial No. 75/482,561)[BONDS.COM is generic for providing information regarding financial products and services on the Internet and providing electronic commerce services on the Internet]; and *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002)[CONTAINER.COM is generic for retail services offered on the Internet featuring metal shipping containers].

The same result must be reached herein. We recognize that applicant is seeking to register COMPUTERLAW.COM rather than COMPUTER LAW.COM. However, the genericness of "computer law" is not negated by compressing the two words into the single compound term COMPUTERLAW since there is no change in commercial impression from COMPUTER LAW. See: In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); and In re A La Vieille Russie Inc., supra. Applicant seeks to register the generic term "computerlaw," which has no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com," which also has no source-identifying significance. See: Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1558 (9th Cir. 1999); and 555.1212.com Inc. v. Communication House International Inc., 157 F.Supp2d 1084, 59 USPQ2d 1453, 1458 (N.D. Cal. 2001). See also: 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition, 7:17.1 at pp. 7-28.1 to 7-29 (4th ed. 2002). Simply put, COMPUTERLAW.COM signifies to the public that the user of the designation is a commercial entity (in this case, a law firm) that specializes in computer law. The fact that applicant's services may not technically be rendered by way

of the Internet, but rather are only offered for sale on the Internet, is of no consequence.

Given the commonly understood meaning of ".com," the involved designation is no different than if applicant were attempting to register COMPUTERLAW FIRM, COMPUTERLAW CO. or COMPUTERLAW LLP. Just as these three designations would be generic for legal services relating to computer law, competitors should be allowed to freely use such designations as JONES COMPUTERLAW FIRM to identify and distinguish their services. In the same manner, a designation such as COMPUTERLAW.COM should be freely available for others to adopt so that designations such as JONESCOMPUTERLAW.COM or SMITHCOMPUTERLAW.COM could be used by competitors to identify and distinguish their legal services from others in the field. See also: Trademark Manual of Examining Procedure, §§ 1209.03(m) and 1215.05 (3rd ed. 2002). Simply put, a designation such as COMPUTERLAW.COM should be freely available for others to use in connection with their legal services in this specialized area of the law.

The existence of third-party registrations of similar marks does not compel a different result in this appeal. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to

determine, based on the record before us, whether applicant's particular mark sought to be registered here is generic. As is often stated, each case must be decided on its own merits. See, e.g.: In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001). Neither the current Examining Attorney nor the Board is bound by the prior actions of Examining Attorneys. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

Even if we had not found the designation COMPUTERLAW.COM to be generic, we nevertheless would find that the designation is merely descriptive. The designation sought to be registered immediately conveys the impression that applicant's legal services involve computer law. The evidence of record clearly shows that the term "computer law" has a specific and commonly understood meaning when it is used in connection with services of the type rendered by applicant.

In finding that the designation COMPUTERLAW.COM is generic for applicant's legal services, we have considered, of course, all of the evidence touching on the public

perception of this designation, including the evidence of acquired distinctiveness. As to acquired distinctiveness, applicant has the burden to establish a prima facie case of acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

In support of its claim of acquired distinctiveness, applicant submitted the declaration of its managing partner, Jack Russo, who attests that applicant has used the designation COMPUTERLAW.COM since November 15, 1995. Applicant also has submitted its California state trademark registration for COMPUTERLAW.COM, and excerpts from its webpage on the Internet.

The Section 2(f) claim, which essentially consists of an allegation of slightly less than five years use prior to the filing date of the application, falls far short due to insufficient evidence. The record is completely devoid of any evidence that purchasers and prospective purchasers view COMPUTERLAW.COM as a distinctive source indicator for applicant's services.

Accordingly, even if the designation COMPUTERLAW.COM were found to be not generic, but merely descriptive, given the highly descriptive nature of the designation COMPUTERLAW.COM we would need to see a great deal more

evidence (especially in the form of direct evidence from customers) than what applicant has submitted in order to find that the designation has become distinctive of applicant's services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. *Yamaha Int'l. Corp. v. Hoshino Gakki Co.*, supra; and *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, supra.

The designation COMPUTERLAW.COM is generic and does not function as a service mark to distinguish applicant's legal services from those of others and serve as an indication of origin. The term sought to be registered should not be subject to exclusive appropriation, but rather should remain free for others in the industry to use in connection with their similar services. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999).

Decision: The refusal to register is affirmed.